

## REMARKS/ARGUMENTS

As previously noted, this Response is filed in reply to the Notice of Non-Compliant Amendment mailed October 19, 2005, setting a one month period for response which expired on November 19, 2005, and is in all respects identical to the Response filed on July 21, 2005, with the exception of adding a listing of claims, the omission of which the Examiner considered to non-compliant with the requirements of 37 CFR 1.121.

Claims 1-70 are pending in the application. Claims 1-70 stand rejected as obvious under 35 U.S.C. § 103(a). Reconsideration is requested.

### *Claim Amendments*

No claims have been changed, cancelled or added.

As explained to the Examiner in the telephone conference of January 3, 2006, 37 CFR 1.121 (c) provides in pertinent part:

Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application.

As further explained to the Examiner in the telephone conference of January 3, 2006, the Response filed on July 21, 2005 did not include a change to an existing claim, cancellation of an existing claim or addition of a new claim and was therefore fully compliant with 37 CFR 1.121, and the Notice of Non-Compliant Amendment mailed October 19, 2005 was clearly improper. In view of the foregoing, the Examiner was requested to withdraw the improper Notice of Non-Compliant Amendment but refused to do so.

***Claim Rejections - 35 U.S.C. §103***

Claims 1-70 stand rejected as obvious over Kawan (US 2002/0065712) in view of Kalthoff (6,026,382) under 35 U.S.C. §103(a). The rejection is respectfully traversed and reconsideration is requested.

***Statement Of Common Ownership Of, Or An Obligation For Assignment To, The Same Person(s) Or Organization(s) Under 35 U.S. §103(c)***

The present application Serial No. 09/684,096 was filed October 6, 2000 claiming priority to Applicants' U.S. Provisional Application No. 60/158,113 filed October 7, 1999. The Kawan reference asserted by the Examiner was filed January 21, 1999 claiming priority to U.S. Provisional Application No. 60/073,093 filed January 30, 1998 and was published on May 30, 2003. The invention of the present application Serial No. 09/684,096 and the invention of the published Kawan reference were, at the time the invention of the present application was made and at all times before and since, owned by Citicorp Development Center, Inc. Therefore, the primary reference, Kawan, asserted by the Examiner is disqualified under 35 U.S. §103(c) from being used as prior art under 35 U.S.C. §102(e) in a rejection under 35 U.S.C. §103(a) against the claims of the present application.

With regard to independent claims 1 and 36, the Examiner asserts the Kawan reference as disclosing each and every element except determining that the ATM user comprises a non-customer, which the Examiner considers to be taught by Kalthoff. Inasmuch as the Kawan reference is disqualified from being used as prior art under 35 U.S.C. §102(e) in a rejection under 35 U.S.C. §103(a) against the claims of the present application, and Kalthoff does not disclose or suggest the required combination of limitations of independent claims 1 and 36, the Examiner has failed to establish the required *prima facie* case of unpatentability. See In re Royka, 490 F.2d 981, 985 (C.C.P.A., 1974) (holding that a *prima facie* case of obviousness requires the references to teach all of the limitations of the rejected claim); See also MPEP §2143.03.

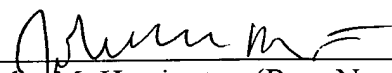
The Examiner has failed to establish the required *prima facie* case of unpatentability for independent claims 1 and 36, and similarly has failed to establish a *prima facie* case of unpatentability for claims 2-35 that depend on claim 1 and claims 37-70 that depend on amended claim 36, and which recite further specific elements that have no reasonable correspondence with the references.

### Conclusion

It is believed that each of the claims remaining in the application is in condition for immediate allowance. Accordingly, the Examiner is requested to reconsider and withdraw the rejection and to pass the application to issue. The Examiner is respectfully invited to telephone the undersigned at (336) 607-7318 to discuss any questions relating to the application.

Respectfully submitted,

Date: 3/20/06

  
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